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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/228,325
Filing Date: January 11, 1999
Appellant(s): Stevens

Evan Witt
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 11/14/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the appeal brief.

(2) *Related Appeals and Interferences*

The appeal brief indicates that there are no related appeals.

(3) *Status of Claims*

The summary of invention contained in the brief is correct.

(4) *Status of Amendments After Final*

The status of amendments after final contained in the brief is correct.

(6) Issues

The appellant's statement of the objective issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement of the grouping of claims is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

<i>Patent Number</i>	<i>Date</i>	<i>Inventor</i>
5839982	11/24/98	<i>Hying et al</i>
4951179	8/21/90	<i>Machida</i>
NPL	3/23/01	✓ <i>GE data sheet</i>
NPL	3/28/01	✓ <i>3M Microspheres Application Guide</i>
NPL	12/98	<i>3M Data Sheet</i>

(10) Grounds of Rejection

- 1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art.*

Claim 1 is rejected under 35 U.S.C. 103(a) as obvious over Hying et al in view of Dow Corning Datasheet. Hying et al discloses a frame (1), an acrylic backboard (3) and the use of an

adhesive to bond (fig 2, 8:45-47) as old art. However Hying does not clearly disclose the type of adhesive used. Dow Corning Datasheet discloses a catalyzed elastomeric adhesive (pg1-type of adhesive-1449 document and the specification pg 5: line10-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the elastomeric adhesive of the Dow Corning Datasheet to attach the backboard and frame in order to prevent injury to the players if the attachment means failed and to take advantage of their desirable properties over wide temperature ranges.

2. Claims 2, 4-18 are rejected under 35 U.S.C. 103(a) as being obvious over **Hying et al** in view of Dow Corning Datasheet as applied to claim 1 above, and further in view of **Nunes and 3M-data**. **Hying et al** discloses the elements in claim 1. However **Hying et al** fails to disclose the specific claimed attachment means. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed various equivalent adhesive means with the apparatus of **Hying et al** in order to insure the apparatus remain attached and to reduce production costs. One skilled in the art would have knowledge of various attachment means and would have selected an appropriate adhesive.

With respect to claim 2: The bond gap claimed is typical in an epoxy paste type application. Double sided adhesive tape would have with a similar thickness. One of ordinary skill in the art would have selected an appropriate amount of adhesive and thickness to insure the backboard was sufficiently attached to the support.

As to claims 4,5,6,14,15: It is not apparent that there is any criticality in the type of adhesive used. It would have been obvious to one skilled in the art at the time of the invention

who was aware of the adhesives available in the art and would have chosen an appropriate adhesive and followed appropriate set time instructions provided by the adhesive manufacturer. The dependent claims merely recite the application instructions of the adhesive. The recitation of following the manufacturer's recommended instructions is does not constitute patentable features of an invention.

With respect to claim 4: Dow Corning Data sheet (Q3-6093) is disclosed as an adhesive which is a catalyzed silicone adhesive (Instant Specification-pg 5 line 11-12).

With respect to claim 5: Dow Corning Data sheet (Q3-6093) discloses a similar set time. Dow Corning Data sheet (Q3-6093) discloses that the working time and snap time are 15 minutes and 25 minutes respectively for a cure ratio of 10:1. The datasheet discloses the curing and set times are adjustable based on the amount of curing agent used (Fig 1-pg 2). A cure ratio of 8:1 would provide a working time and snap time of 9 and 15 minutes respectively ($15/25=0.6$ $15*0.6=9$). One of ordinary skill in the art would have followed the manufacture's suggested application rules to insure a satisfactory bond.

With respect to claims 6, 15: Dow Corning Data sheet (Q3-6093) discloses a snap time of 15-60 minutes (Fig 1-pg 2). One of ordinary skill in the art would have followed the manufacture's suggested application rules to insure a satisfactory bond.

As to claim 14: See base claim rejection.

As to claims 7-10, 16-18 :It is not apparent that there is any criticality to the step of providing bond gap spacers in an adhesive. Including glass micro spheres of various sizes is well known in the art (3M data sheet- pg 2). It would have been obvious to one of ordinary skill in the

art in view of the 3-M data sheet to have included micro spheres in the adhesive in order to reduce the amount of adhesive used and insure the adhesive bonded uniformly. The use of this ingredient is common knowledge, the dependent claim language merely recites the use of the ingredient with the adhesive.

With respect to claims 11,12: **Hying et al** discloses a metal frame structure (5:62-65). It is not apparent that there is any criticality in painting the metal. It is well known in the art to paint metal in order to prevent corrosion and improve marketability.

Claim 13 is rejected under 35 U.S.C. 103(a) as obvious over the prior art cited in view of Nunes. The cited art fails to disclose the printing of indicia on the backboard. Nunes discloses the placing of indicia on an acrylic surface (fig 3, 2:30-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included indicia on the backboard to more easily permit the placing of the adhesive and frame during assembly. It is not apparent that there is any criticality to the step of adding indicia, it is well known to place position marks on articles to insure they are properly placed when bonded together.

As to claims 16-18: See claim rejection for claims 7-10. Including glass micro spheres is well known in the art (3M data sheet- pg 2). It would have been obvious to one of ordinary skill in the art to have included micro spheres in the adhesive in order to reduce the amount of adhesive used and insure the adhesive bonded uniformly.

(11) Response to Arguments

I. Claim 1 would not have been obvious under 35 USC 103(a) because Hying et al and Dow Corning Data sheet do not motivate or suggest a basketball backboard assembly containing a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface as claimed and because no reasonable expectation that the claimed invention would succeed in found in the cited prior art.

The applicant's argument is that Hying et al teaches away from using adhesive as a bonding means. This argument is not understood. Hying et al teaches that using an adhesive to bond an acrylic backboard to a support is old art. The claim language calls for a backboard, a support structure and the use of an adhesive to bond the articles together. Also it should be noted that Hying acknowledges that double sided tape and adhesives can be used (8:46-47). Also looking at section 2 line 15 of Hying, the disclosure merely states that a backboard is attached by a double sided adhesive layer. Any adhesive layer used would of necessity have to have two sides of adhesion in order for the backboard to be attached to the support structure. The question then shifts to whether or not it would have been obvious to one of ordinary skill in the art to have used any common adhesives in the manner prescribed by the adhesive manufacturer.

The Dow Corning Datasheet discloses the use of the generic "catalyzed silicon adhesive". The claims merely recite using a commonly available adhesive and bond gap spacers to bond two dissimilar materials. This is an obvious variation and thus falls under the 103(a) rejection. The substitution of a new and more desirable material for an older material is not patentable (Rex Chainbelt Inc V Harco Products--181USPQ432).

The applicant also argues that the rejection is based on the picking and choosing of segments of the prior art in forming the rejection. As noted above, the Hying patent notes that is old to use adhesives to bond the backboard to the support structure. The adhesive claimed is common and well known. It would be an obvious choice for one of ordinary skill in the art to use a readily available adhesive in the attachment of the backboard to the support.

II The primary reference, Hying et al teaches away from the claimed invention where it states at column 2, lines 15-16 and 24-27 that the most notable disadvantage of double sided tape acrylic backboard construction “is the use of adhesive material” and teaches that double-sided tape be replaced with non-adhesive plastic retainers.

As noted above, the Hying et al patent establishes that the use of adhesive is well known in the art. Although the Hying et al art details a means of attachment, this is a secondary consideration. If one reads the abstract of Hying (line 4), section 3:31-67, and independent claims 1 and 29 the thrust of the invention is towards a plastic retainer to protect the edge of the backboard. The independent claim language does not claim the plastic retainer means to attach the backboard to the support structure.

III Claims 2 and 4-18 would not have been obvious under 35 USC 103(a) because Hying et al, Dow Corning Datasheet, Nunes and 3M data do not motivate or suggest a basketball assembly containing a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface and other dependent claim features as claimed and because no reasonable expectation that the claimed invention would succeed is found in the cited prior art.

The applicant provided data sheets on adhesives but did not provide any information on the use of glass bead bond spacers which are also old and conventional in the art. The use of spacers to maintain an appropriate bond gap is well known. The argument appears to be that it would not be obvious to use well known adhesive means to attach two objects. The applicant has simply used conventional adhesives and bond spacers in a conventional manner. This is not novel, nor would it have been unobvious to one of skill in this art.

IV The Examiner misapplied section 103(a) when he indicated that the Appellant had the burden of proving “that one skilled in the art would not be aware of various forms of attachment means,” i.e. adhesives.

This argument is not understood. The main thrust of the office actions has been to show that the claimed invention is merely using an adhesive and bond gap spacers in their prescribed manner. The applicant is correct in their statement of the requirements for a 103(a) rejection, but they fail to focus on aspect of “knowledge generally available to one of ordinary skill”. The applicant has never claimed to have modified or adjusted the normal instructions for using the adhesive and spacers. Therefore the general use of an adhesive in the manner prescribed is not novel and non-obvious.

V The evidence set forth in the Declaration of Jerry Ward of superior mechanical performance and huge manufacturing cost and labor savings associated with the present invention demonstrates the non-obviousness of the claimed invention


The declaration of Jerry Ward is not persuasive. The declaration of Jerry Ward details that the adhesive is better in cold climates and it is more economical to use than double sided tape. Cost savings is a conventional design consideration. There is a variety of equivalent attachment

means available to one of ordinary skill in the art. If one of ordinary skill were to use an attachment means using bolts and nuts, the ability to withstand cold climates would be 100%. Since there is a variety of attachment means available to one of ordinary skill in the art, one would expect there would be a variety of attachment efficiencies in cold weather. The cost savings associated with the use of the claimed invention would also occur if another well known adhesive were used.

The declaration of Curtis Nye is not persuasive. As noted above, there are various equivalent attachment means for attaching the backboard to the support. Earlier the applicant argues that Nye (assignee Huffy) teaches away from using adhesives and using plastic fasteners. Then the declaration argues the assignee (assignee Huffy) uses double sided tape. As noted above, Nye merely discloses that the use of adhesives is old. The use of adhesives by one or more of their competitors does not show non-obviousness, it would appear to establish instead that the use of appropriate adhesives is conventional in the art.

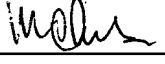
For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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msc
February 15, 2002

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